

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRANSMITTAL FORM



Applicant(s): Norbert Marocco et al.
Serial No.: 09/814,261
For: SINGLE PLATE CUT DOWN APPARATUS
Filed: March 21, 2001
Examiner: Not Yet Assigned
Art Unit: 3724
Confirmation No.: 5581

Attorney Docket: 625.0006USQ

Date: August 28, 2002

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with the duty of disclosure set forth in 37 C.F.R. § 2.56, applicant wishes to advise the Office of certain information which may or may not be material to the examination of the above-referenced application. Nothing herein should be construed as an admission or an acknowledgement that any matter discussed herein is prior art to the present application. We are enclosing form PTO-1449 and a copy of the citation that is listed therein:

Documents from case of: **Springs Window Fashions LP and Shade-O-Matic Ltd. VS Novo Industries, L.P.**

I. BACKGROUND

The information discussed herein was developed in discovery

in a civil action styled *Springs Window Fashions LP, Shade-O-Matic Ltd. and Manor Tec, Inc. V. Novo Industries, L.P.*, Civil Action No.01-0400 5, in the United States District Court for the Western District of Wisconsin ("the Wisconsin Action"). This was an action for infringement of U.S. Patent No.6,178,857 ("the '857 patent") which names Norbert Marocco as inventor and which is assigned to Shade-O-Matic Ltd., one of the plaintiffs in the aforesaid action. The '857 patent issued out of U.S. Patent Application No.09/132,750, which was a continuation-in-part of Application No.08/627,015, filed April 3, 1996, and now U.S. Patent No. 5,806,394. That application was a continuation-in-part of Application No.08/526,329, filed on September 11, 1995, and subsequently abandoned.

On February 25, 2002, the court in the Wisconsin Action issued a Memorandum and Order granting summary judgment of noninfringement to the defendant Novo. A copy of that decision is annexed hereto as Tab A. Thereafter, on March 8, 2002, the court in the Wisconsin Action entered a final judgment which, *inter a/ia*, dismissed the plaintiffs' complaint with prejudice and costs and declared that the defendant's accused blind cutter does not infringe the '857 patent. A copy of that judgment is annexed as Tab B. An appeal of that judgment has been initiated to the United States Court of Appeals for the Federal Circuit and docketed as Appeal No. 02-1309.

In the Wisconsin Action, the defendant Novo took a number of depositions of individuals associated with Shade-O-Matic (the assignee of the '857 patent) and Springs (the exclusive licensee of the '857 patent). At least significant portions of those depositions were designated (at least provisionally) as

confidential under a protective order in place in that action. For that reason, and since only certain portions of those depositions are believed to relate to issues of patentability, applicant is only submitting copies of those excerpts of the depositions which are discussed herein. As to those excerpts, claims of confidentiality are herein waived, such that applicant is not invoking the procedures of M.P.E.P. § 724.

II. SPRINGS CUT-DOWN MACHINES

Certain of the information developed in discovery in the Wisconsin Action relates to cut-down machines manufactured and/or used by Springs Window Fashions Division, Inc., a licensee under the '857 patent and related patents and applications, as well as its predecessor, Carey-MeFall Corporation. Certain of this information expands upon an Information Disclosure Statement that was filed during prosecution of the '857 patent and in other related applications. A copy of the prior Information Disclosure Statement as filed in what became the '857 patent is annexed hereto as Tab C.

The information discussed herein relating to Springs cut-down machines was developed in depositions of Gerald Franzen and Roy H. Wepner. Copies of the cited portions of the Franzen and Wepner declarations are annexed hereto as Tabs D and E respectively. In addition, copies of exhibits referred to in the cited Franzen and Wepner deposition testimony are also attached.

Mr. Franzen's testimony generally relates to various prior cutting technologies for blind components (at pp.17-31); a Springs "Prototype" machine (at pp. 32-42 and 104-112, and

Exhibit 62 (Tab Z)); a cut-down machine referred to as machine "A" (at pp. 47-61 and Exhibit 59 (Tab W)); a machine referred to as the DURAFLEX machine (at pp.61-94 and 116-120, and Exhibit 60 (Tab X)); and a machine referred to as the "BALI TODAY" machine (at pp. 94-98 and Exhibit 61 (Tab Y)). Mr. Wepner's testimony relates to the DURAFLEX machine (at pp.100-103 and Exhibit 69 (Tab CC)), and also relates to correspondence which discusses the various Springs cut-down machines (at pp.83-90 and Exhibits 63 (Tab AA) and 67 (Tab BB)).

While Applicant has noted the general subject matters to which the cited portions of Mr. Franzen's and Mr. Wepner's testimony relate, the Examiner is urged to review the attached testimony, as well as the accompanying exhibits, in order to form his or her own conclusion as to the pertinence (if any) of the information submitted herewith. If the Examiner wishes to review any additional exhibits, the undersigned counsel should be contacted.

III. MR. MAROCCO'S AND MR ROLSTON'S TESTIMONY

During the *Springs V. Novo* litigation, the deposition of the inventor of the '857 patent, Norbert Marocco, was taken, as well as the deposition of his attorney, Mr. George Rolston.

Excerpts of Mr. Marocco's deposition are annexed hereto as Tabs F and 0 Mr. Marocco speaks

English as his second language; and while he was examined in English, he considered it to be

"torture." (Marocco 2/20/02 Dep. (Tab G), at 46-50.86-95.)

Mr. Marocco's testimony which is being submitted herewith

generally dates to alleged prior art asserted by DH (Canada) International Ltd. (see Marocco 2/19102 Dep. (Tab F) at pp.143-167 and Exhibits 19 (Tab J) and 20 (Tab K)), and to a number of other matters or documents (see Marocco 2/19/02 Dep. (TabF) at pp.104-116, 125-126, 179-183, and Exhibits 16 (Tab I) and 23-26 (Tabs L, M, N and O)).

Mr. George Rolston is a registered patent agent in Canada as well as a lawyer (Roiston Dep. (Tab H) at 12), and has represented the inventor Norbert Marocco and his assignee Shade-O-Matic in various patent matters (*id.* at 31-32). Mr. Rolston's testimony which is being submitted herewith in part relates to certain alleged prior art asserted by DH (Canada) International Ltd. in response to a letter calling attention to a pending Canadian patent application of Mr. Marocco (see Rolston Dep. at pp.34-56, 119-132 and Exhibits 19 (Tab J), 20 (Tab K) and 44-46 (Tabs?, Q and R)). The pending Canadian application claims priority based upon U.S. Patent Application 08/526,329, filed September 11, 1995, which is the grandparent application of the '857 patent. Mr. Rolston's testimony also relates to certain searches he conducted (see Rolston Dep. at pp.97-104 and Exhibits 23-26 (Tabs L, M, N and O), 54-57 (Tabs S, T, U and V)).

Separate and apart from the Marocco depositions, Shade-O-Matic Ltd. (the assignee of Mr. Marocco's applications) has received a protest in connection with the subject Canadian application. A copy of the protest is submitted herewith as Tab DD.

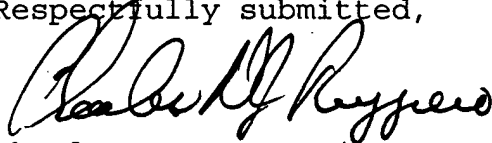
It is applicant's belief that the above-citation does not described that which is claimed, in the present invention.

It should be understood that attention has been called to the citation that has been deemed to be pertinent to the claimed present invention. In concluding what was pertinent, the criteria employed was considered most appropriate in light of the invention shown in the present application. However, the Examiner or others may deem some other criteria to be just as appropriate or more appropriate. Therefore, the Examiner is respectfully urged to review the listed patent to make the usual careful independent search for other prior art that may be pertinent.

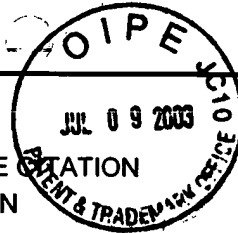
Since this Information Disclosure Statement is being filed before the issuance of a first Office Action, no fee is required.

Applicant respectfully requests favorable consideration and that this application be passed to allowance.

Respectfully submitted,



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FORM PTO-1449

INFORMATION DISCLOSURE CITATION
IN AN APPLICATION

(Use several sheets if necessary)

Docket Number (Optional)

625.0006USQ

Application Number

09/814,261

Applicant

Marocco

Filing Date

March 21, 2001

Group Art Unit

3724

U. S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER | DATE | NAME | CLASS | SUBCLASS | FILING DATE IF APPROPRIATE |
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FOREIGN PATENT DOCUMENTS

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OTHER DOCUMENTS (including Author, Title, Date, Pertinent Pages, Etc.)

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| | Documents from case of: <i>Springs Window Fashions LP and Shade-O-Matic Ltd. VS Novo Industries, L.P.</i> , Memorandum and Order 01-C-400-S, vol. 1 and 2. |
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EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP §609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

FORM PTO-1449

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(Use several sheets if necessary)

Docket Number (Optional)

625.0006USX

Applicant

Norbert Marocco

Filing Date

Herewith

Application Number

NYA

Group Art Unit

NYA

U. S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

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